

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Shalini Sharma Atty. Ref.: 18037-PCTUS
Appl. No.: 10/566,302 Group Art Unit: 1625
Filed: March 1, 2007 Examiner: Covington, Raymond K.
Conf. No.: 5040 Customer No.: 31976

Title: COMPOUNDS FOR THE TREATMENT OF METABOLIC DISORDERS

* * * * *

January 14, 2010

Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMUNICATION IN RESPONSE TO NOTICE OF ALLOWABILITY

Sir:

This Communication is being submitted in response to the Notice of Allowability, dated January 8, 2010, in connection with the above-identified patent application. The Notice set an unextendable deadline of three months from its mailing date to file a reply. Accordingly a reply is due April 8, 2010 and this Communication is being timely filed.

The Notice set forth certain requirements that applicant is allegedly required to comply with. And it stated that failure to comply with those requirements will result in abandonment of this application. Each of those supposed requirements is nonexistent. Moreover, applicants request an initialed copy of the Information Disclosure Statement filed October 30, 2009.

CORRECTION OF INVENTORSHIP

On October 30, 2009, applicants submitted a Communication Requesting Correction of Inventorship Under 37 CFR 1.48(b). The Notice purported to find the Communication defective for failure to include certain items. The omitted items are not requirements for correction of inventorship under Rule 1.48(b).

The Notice stated:

The request for the deletion of an inventor . . . under 37 CFR 1.48(b) is deficient because:

An oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted.

It lacks the written consent of any assignee of one of the originally named inventors.

The request was not accompanied by the statement under 37 CFR 1.48(b)(2).

Notice of Allowability, p. 2. Contrary to the Notice, none of those things is required. It appears that the Office has confused the requirements for correction of inventorship under 37 CFR 1.48(a) with the requirements for correction of inventorship under 37 CFR 1.48(b).

On October 30, 2009, applicants submitted a Communication Requesting Correction of Inventorship Under 37 CFR 1.48(b). Rule 1.48(b) provides:

Nonprovisional application – fewer inventors due to amendment or cancellation of claims. If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. Amendment of the inventorship requires:

- (1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and
- (2) The processing fee set forth in § 1.17(i).

37 CFR 1.48(b). The correct inventive entity was named in the application as filed and in the Declaration filed on March 1, 2007. The October 30, 2009, Communication identified the originally-named inventors being deleted and stated that the invention of the deleted individuals is no longer being claimed in view of the Amendment filed October 30, 2009, as required under Rule 1.48(b)(1). The Communication was signed by a patent practitioner of record in accordance with Rule 1.33(b). The fee prescribed by Rule 1.17(i) was paid, as required under Rule 1.48(b)(2). Thus all of the requirements of Rule 1.48(b) were met, and the Request for Correction of Inventorship filed on October 30, 2009, was not deficient.

Contrary to the Notice, correction of inventorship under Rule 1.48(b) does not require an oath or declaration signed only by the inventors of the inventive entity remaining after the cancellation or amendment of claims. Nor does it require written consent of the assignee. And Rule 1.48(b)(2) does not require a statement, just a processing fee.

Correction of inventorship under 37 CFR 1.48(a) does require:

- (2) A statement from each person being added . . . and from each person being deleted
- (3) An oath or declaration by the actual inventor or inventors. . . .
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee

37 CFR 1.48(b). But those requirements under Rule 1.48(a) do not apply to a request for correction of inventorship under Rule 1.48(b). Therefore the requirement to submit them in this case is improper and should be withdrawn.

DEPOSIT OF BIOLOGICAL MATERIAL

The first page of the Notice also stated that “Examiner’s Comment Regarding Requirement for Deposit of Biological Material 10/30/09” is attached. No such comment was attached to the Notice. It is believed that the inclusion of the quoted statement in the Notice of Allowability for this application was a clerical error.

IDS ENTITLED TO CONSIDERATION

On October 30, 2009, applicant submitted an Information Disclosure Statement (IDS). It contained a Statement under 37 CFR 1.97(e) and the fee under 37 CFR 1.17(p). Accordingly, the IDS is entitled to consideration. Applicant respectfully requests a copy of the Form PTO/SB/08a initialed by the Examiner.

No fee is believed necessary in connection with the filing of this Communication. If any fee is required, the Commissioner is hereby authorized to charge the amount of such fee, or to refund any overpayment, to Deposit Account No. 50-1677.

Respectfully submitted,

/Lewis J. Kreisler/

Lewis J. Kreisler
Reg. No. 38522
Attorney for Applicant(s)

930 Clopper Road
Gaithersburg, MD 20878
Phone: (240) 631-2500 x3276
Facsimile: (240) 683-3794